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EXAMINER

NGUYEN, VAN H

ART UNIT PAPER NUMBER

2194

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/839,263

Applicant(s)

KITADA ET AL.

Examiner

VAN H. NGUYEN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-20, 22-40 and 42-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-20, 22-40, and 42-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. Claims 2-20, 22-40, and 42-55 are pending in this application.
2. It is noted that applicant has other related application (i.e., application 09/684,965 filed October 10, 2000). It is requested that any related application be referred to in the first sentence of the specification. Applicant is also requested to supply the serial numbers of any other related applications currently pending before the U.S Patent & Trademark Office.

### ***Double Patenting***

3. **Obviousness-type double patenting rejection**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Uogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

4. A timely filed terminal disclaimer in compliance with 37 C.F.R. ' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. ' 1.78(d).
5. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR

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3.73(b).

6. Claim 2 is are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending application 09/684,965 filed October 10, 2000 in view of Navarre et al. (U.S. 6, 442,611 B1).

7. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of instant application and claim 1 of copending application'965 are both claiming a system for communicating over a protocol; receiving a request; selecting an application service provider; transmitting instructions for performing the transaction request, via the communications network. The difference between claim 2 of instant application and claim 1 of copending application'965 is claim 2 of instant application further recites a document profile. Navarre teaches a document profile (col.4, lines 47-60 and fig. 3). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Navarre and copending application'965 because Navarre's teaching would have provided the capability for efficiently selecting an appropriate service provider to satisfy a request from a user.

8. As to the remaining claims 3-20, 22-40, and 42-55, they are also rejected under obvious type double patenting as stated in claim 1 above.

9. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. **Claims 2-20, 22-40, and 42-55** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Navarre et al.** (U.S. 6, 442,611 B1) in view of **Miller et al.** (U.S. 5, 475,819).

12. **As to claim 2**, Navarre teaches (abstract) the invention substantially as claimed including a method for managing applications service provider transactions (*transactions*) between an ASP (*server application*) and an ASP user (*a client application*), comprising:

receiving an ASP transaction request having a user identifier from the user via a communications network (col.2, line 50 - col.3, line 29 and fig. 3);

determining whether a document profile exists for the user identifier received (col.4, lines 47-60 and fig. 3);

sending to the user a document manager interface screen based on the determination of whether a document profile exists (col.4, lines 58-60);

receiving a request from the interface screen (figs. 2 and 3 and the associated text); and  
transmitting instructions for performing the transaction request, via the communications network (col.2, lines 50-65; col.3, lines 30-31; and fig.3).

Navarre does not specifically teach “selecting an ASP.”

Miller teaches selecting an ASP (col.2, lines 9-25).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Miller and Navarre because Miller's teaching would have provided mechanisms to automatically: (1) efficiently map a (flat) name of a service into a set of service providers; (2) customize the mapping of services into service providers based on a user, system, LAN, site, organization, etc.

13. **As to claim 3**, Navarre teaches determining whether a document profile exists comprises determining that a document profile does exist by locating a document profile associated with the user identifier in a memory which is local to a processing device which performs the step of determining whether a document profile exists (col.2, lines 26-49 and col.4, lines 47-60).

14. **As to claim 4**, Navarre teaches step of sending a document manager interface screen comprises sending an interface screen including a document profile menu that lists the document profile located in the memory (col.4, lines 47-60 and fig.4).

15. **As to claim 5**, Navarre teaches receiving a document profile selection from the user via the communications network based on a user input to the document profile menu (col.4, lines 47-60).

16. **As to claim 6**, Navarre teaches selecting a basic ASP using the document profile selection received (col.2, lines 26-49 and col.3, lines 1-29).

17. **As to claim 7**, Navarre teaches determining a document type using the document profile selection received; and selecting the basic ASP that performs services utilized with the document type (col.2, lines 26-49 and col.3, lines 1-29).

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18. **As to claim 8**, Navarre teaches determining that a document profile does not exist by searching a memory which is local to a processing device which performs the step of determining whether a document profile exists (col.2, lines 26-49 and col.4, lines 47-60).

19. **As to claim 9**, Navarre teaches the step of sending a document manager interface screen comprises sending an interface screen including a document type menu (col.4, lines 47-60).

20. **As to claim 10**, Navarre teaches receiving a document type selection from the user via the communications network based on a user input to the document type menu (col.4, line 47-col.5, line15).

21. **As to claim 11**, Navarre teaches the step of selecting an ASP comprises selecting a basic ASP that performs typical services utilized with the document type selection received (col.3, lines 1-29 and col.5, line 3-15).

22. **As to claim 12**, Navarre teaches creating a document profile based on the document type selection received; and storing the document profile in association with a user identifier in a local memory (col.4, lines 47-60 and fig.4).

23. **As to claim 13**, Navarre teaches the step of receiving an ASP transaction request comprises receiving a document consultation request from the user (col.2, line 66-col.3, line 29).

24. **As to claim 14**, Navarre teaches sending, in response to receiving the document consultation request, a document manager interface screen including a document type menu to the user via the communications network; generating a document type selection from a user input to the document type menu; and receiving the document type selection via the communications network (col.2, line 66-col.3, line 29 and col.4, lines 47-60).

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25. **As to claim 15**, Navarre teaches the step of selecting an ASP comprises selecting a basic ASP that performs services utilized with the document type selection received (col.2, lines 26-49 and col.3, lines 1-29).
26. **As to claim 16**, Navarre teaches creating a document profile based on the document type selection received; and storing the document profile in association with a user identifier in a memory (col.4, lines 47-60 and fig.4).
27. **As to claim 17**, Navarre teaches selecting a special service ASP for providing special services independently offered by an ASP (col.3, lines 1-45).
28. **As to claim 18**, Navarre teaches receiving a request for a special service from the user via the communications network; and locating in a memory, a special ASP associated with the special service request received (col.3, lines 1-45 and col.4, lines 1-23).
29. **As to claim 19**, Navarre teaches receiving an ASP transaction request from the user and transmitting instructions for performing the transaction requested comprise transferring data via the Internet (col.3, lines 1-11).
30. **As to claim 20**, a computer readable medium containing program instructions is inherent to the system of Navarre.
31. **Claims 40 and 42-55** are directed to a system for performing the method of claims 2-16, and are similarly rejected under the same rationale.
32. **Claim 22** is also directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale. Claim 22, however, further recites a memory device and a processor. Navarre teaches a memory device and a processor (fig. 1).



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33. As to claims 23-39, note the rejection of claims 3-19 above. Claims 23-39 are the same as claims 3-19, except claims 23-39 are system claims and claims 3-19 are method claims.

### ***Response to Arguments***

34. Applicant's arguments filed 20 September 2005 have been fully considered but they are not persuasive.

35. In the remarks, Applicant argued in substance that (a) Claims 2-20, 22-32, 40 and 42-55 are pending in the case; and (b) Navarre does not teach the step of determining whether a document profile exists for the user identifier received.

36. Examiner respectfully traverses Applicant's remarks.

37. As to point (a), for claims 33-39 have not been cancelled, claims 2-20, 22-40, and 42-55 are pending in the application.

38. As to point (b), Navarre teaches determining whether a document profile (e.g., the user profile) exists for the user identifier received (col.4, lines 47-60). The scope of the claimed "a document profile" clearly transcends the more narrow scope that Applicant attempts to impute through argument. Claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art, *In re Self*, 213 USPQ 1 (CCPA 1982), *In re Priest*, 199 USPQ 11 (1978). The recited "a document profile" is clearly subject to a broad interpretation as detailed in the rejections maintained above. The Examiner has a duty and responsibility to the public and to Applicant to interpret the claims as broadly as reasonably possible during prosecution. *In re Prater*, 415 F.2d 1

393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” In re Hyatt 21 1 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

### ***Conclusion***

39. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

40. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

41. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765.

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The examiner can normally be reached on Monday-Thursday from 8:30AM - 6:00PM. The examiner can also be reached on alternative Friday.

43. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

44. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

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